AF/2624

FEE TRANSMITTAL FOR FY 2004

(FY 2004 Begins 10/01/2003)

TOTAL AMOUNT OF PAYMENT ($) 330.00

$

250

Complete if Known:

Application No. 09/902,515
Filing Date July 9, 2001
First Named Inventor Collins
Examiner Name Chen, Wenpeng
Art Unit 2624
Attorney Docket No. 005545.P002

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that I am causing the above-referenced correspondence to be deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and that this paper or fee has been addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date of Deposit: March 8, 2004

Name of Person Mailing Correspondence: Leah Schwenke

Leah Schwenke — Signature

3/8/04 — Date

____ **Applicant claims small entity status. See 37 C**

METHOD OF PAYMENT (check all that apply)

__X__ **Check** _____ **Credit Card** _____ **Money Order** _____ **Other** _____ **None**

__X__ **Deposit Account**

Deposit Account Number : 02-2666

Deposit Account Name:

__X__ **The Director is Authorized to do the following with respect to the above-identified Deposit Account:**

____ **Charge fee(s) indicated below.**

__X__ **Credit any overpayments.**

__X__ **Charge any additional fees during the pendency of this application.**

__X__ **Any concurrent or future reply that requires a petition for extension of time should be treated as incorporating an appropriate petition for extension of time and all required fees should be charged.**

____ **Charge fee(s) indicated below except for the filing fee.**

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility application filing fee	
1002	340	2002	170	Design application filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional application filing fee	

SUBTOTAL (1) $ 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	_____	– 20** =	_____	X _____	=	_____
Independent Claims	___	– 3** =	_____	X _____	=	_____
Multiple Dependent				_____	=	_____

**Or number previously paid, if greater; For Reissues, see below.

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) $ 0.00

Based on Form PTO/SB/17 (08-03) as modified by BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP on 09/30/03.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1813	8,800	1813	8,800	Request for inter parties reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive – unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	For filing a submission after final rejection (see 37 CFR 1.129(a))	
1814	110	2814	55	Statutory Disclaimer	
1810	770	2810	385	For each additional invention to be examined (see 37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
1504	300	1504	300	Publication fee for early, voluntary, or normal pub.	
1505	300	1505	300	Publication fee for republication	
1803	130	1803	130	Request for voluntary publication or republication	
1808	130	1808	130	Processing fee under 37 CFR 1.17(i) (except provisionals)	
1454	1,330	1454	1,330	Acceptance of unintentionally delayed claim for priority	
Other fee (specify)					
Other fee (specify)					

SUBTOTAL (3) $ 330.00

*Reduced by Basic Filing Fee Paid

SUBMITTED BY:

Typed or Printed Name: Mark L. Watson

Signature: _____ Date: March 8, 2004

Reg. Number: 46,322 Telephone Number: 303-740-1980

Send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Based on Form PTO/SB/17 (08-03) as modified by BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP on 09/30/03.

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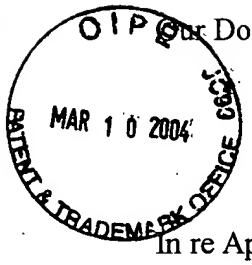

Our Docket No.: 005545.P002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Roger Collins

Application No.: 9/902,515

Filed: July 9, 2001

For: System and Method for Compressing Using Field-Based Code Word Generation

Examiner: Chen, Wenpeng

Art Group: 2624

APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Appellant hereby submits this Brief in triplicate in support of its appeal from a final decision by the Examiner, mailed October 6, 2003, and within the two-month period following a notice of appeal filed on January 6, 2004, in the above-referenced Application. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

An oral hearing is not desired at this time.

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I. REAL PARTY IN INTEREST

The invention is assigned to Good Technology, Inc., currently of 1032 Morse Avenue, Sunnyvale, California 94089.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision.

III. STATUS OF THE CLAIMS

Claims 1, 4-5, 9, 12, 14, 22 and 25-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,293,379 of Carr ("*Carr*") in the Final Office Action mailed October 6, 2003. Claims 2, 3, 10-11, 16 and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Carr* in view of U.S. Patent 5,991,713 of Unger et al. ("*Unger*"). Claims 1-12, 14-16 and 22-29 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

An Amendment After Final Action under 37 C.F.R. § 1.116 was submitted in response to the Final Office Action mailed on October 6, 2003. In response, the Examiner mailed an Advisory Action on December 23, 2003 maintaining the claim rejections. A copy of all claims on appeal is attached hereto as an Appendix of Claims.

V. SUMMARY OF THE INVENTION

According to one embodiment, a method is disclosed. The method includes identifying a first field and a second field within an electronic mail (email) message, applying a first set of code words to encode data in the first field, and applying a second set of code words to encode data in the second field.

In a further embodiment, another method is disclosed. The method includes generating a first code word table containing code words for a plurality of character strings found in a first electronic mail (email) message field, generating a second code word table containing code words for a plurality of character strings found in a second email message field and encoding character strings in the first field using the first code word table and character strings in the second field using the second code word table.

In yet another embodiment, a machine readable medium is disclosed having program code stored thereon which, when executed by a machine, causes said machine to perform the operations of identifying a first field and a second field within an electronic mail (email) message, applying a first set of code words to encode data in said first field and applying a second set of code words to encore data in said second field.

VI. ISSUES PRESENTED

1. Whether claims 1, 4-5, 9, 12, 14, 22 and 25-26 are patentable over *Carr*; and

2. Whether claims 2, 3, 10-11, 16 and 23-24 are patentable over *Carr* in view of *Unger*;

VII. GROUPING OF CLAIMS

The claims do not stand or fall together.

For the purposes of this appeal:

Claims 1-8 and 22-29 stand or fall together as Group I; and

Claims 9-16 stand or fall together as Group III.

Reasons for separate patentability of the above-indicated Claims Groups I and II are presented in the arguments section pursuant to 37 C.F.R. §1.192 (c)(7).

VIII. ARGUMENT

Claim Group I

A. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. §102(B) BECAUSE *CARR* DOES NOT DISCLOSE IDENTIFYING A FIRST FIELD AND A SECOND FIELD WITHIN AN ELECTRONIC MAIL (EMAIL) MESSAGE

Appellant respectfully submits that *Carr* fails to disclose the claimed invention for the reasons set forth below.

Each claim in Claim Group I recites an element that is not disclosed in *Carr*. For example, Appellant's claim 1 recites the following:

> A method comprising:
> identifying a first field and a second field within an electronic mail (email) message;
> applying a first set of code words to encode data in said first field; and
> applying a second set of code words to encore data in said second field.

Appellant's Claim 22 recites:

> A machine readable medium having program code stored thereon which, when executed by a machine, causes said machine to perform the operations of:
> identifying a first field and a second field within an electronic mail (email) message;
> applying a first set of code words to encode data in said first field; and
> applying a second set of code words to encore data in said second field.

Carr discloses a data processing system employing a compression method. See *Carr* at Abstract. The method includes reformatting each data packet in the data processing system by associating its static fields with a first packet region and its dynamic fields with a second packet region. The process then assembles a static table that includes static information from at least an initial data packet's first packet region. It

then identifies static field information in a subsequent data packet's first packet region that is common to the information in the static table. Such common information is encoded so as to reduce its data length. The common static information is then replaced in the modified data packet with the encoded common static information and the modified data packet is then transmitted. A similar action occurs with respect to user-data information. A single dictionary table is created for all packet headers, while separate dictionary tables are created for each user-data portion of a packet-type experienced in the communication network thereby enabling better compression. Id.

Appellant submits that there is no disclosure in *Carr* of identifying a first field and a second field within an email message. Moreover, nowhere in *Carr* are email messages disclosed. The Examiner asserts that:

> Carr Teaches transferring messages through a network such as LAN and WAN as shown in Fig. 1. As pointed out in paper #6, a message transferred in a network is an email. The set of static, semi-static and dynamic fields is an email header. The fields are inside an email are fields within an email.

See Final Office Action at page 2, paragraph 1.

Appellant strongly disagrees with the Examiner's assertion that a message transferred within a network is an email message. One of ordinary skill in the art would define an email message as the exchange of computer-stored messages by telecommunication that are usually encoded in ASCII text, graphic images and sound files, as attachments transmitted in binary streams. As discussed above, nowhere in *Carr* is there disclosed the implementation of email messages, only field information within data packets. Therefore, *Carr* cannot disclose identifying a first field and a second field within an email message. Therefore, Claim Group I is patentable over Carr.

For the foregoing reasons, Appellant submits that the Examiner has failed to search and find a printed publication or patent that discloses the claimed invention as set forth in MPEP § 706.02(a).

Claims 2-8 depend from Claim 1, and Claims 23-29 depend from Claim 22. Given that dependent claims necessarily include the limitations of the claims from which they depend, Appellant submits that the invention as claimed in claims 2-8 and 23-29 are similarly not anticipated by *Carr*.

Thus, the Examiner erred in rejecting claims 1-8 and 22- 29 under U.S.C. § 102(b).

B. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 103(A) BECAUSE NEITHER *CARR* NOR *UNGER* DISCLOSE OR SUGGEST IDENTIFYING A FIRST FIELD AND A SECOND FIELD WITHIN AN ELECTRONIC MAIL (EMAIL) MESSAGE

The Claims of Claim Group I are not obvious in view of *Carr* in view of *Unger* under 35 U.S.C. § 103(a). *Unger* discloses a method for compressing text including parsing words from text in an input file and comparing the parsed words to a predetermined dictionary. The dictionary has a plurality of vocabulary words in it and numbers or tokens corresponding to each vocabulary word. A further step is determining which of the parsed words are not present in the predetermined dictionary and creating at least one supplemental dictionary including the parsed words that are not present in the predetermined dictionary. The predetermined dictionary and the supplemental dictionary are stored together in a compressed file. Also, the parsed words are replaced with numbers or tokens corresponding to the numbers assigned in the predetermined and supplemental dictionary and the numbers or tokens are stored in the compressed file. See *Unger* at Abstract.

Nevertheless, *Unger* does not disclose or suggest identifying a first field and a second field within an email message. As discussed above, *Carr* does not disclose or suggest such a limitation. As a result, any combination of *Carr* and *Unger* would also not disclose or suggest identifying a first field and a second field within an email message.

For the foregoing reasons, Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness as set forth in MPEP § 706.02(j). Specifically, the Examiner has failed to show that "[t]he teaching or suggestion to make

the claimed combination ... [is] found in the prior art, and not based on Appellant's disclosure," as required by In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Thus, the Examiner erred in rejecting claims 2, 3, 23 and 24 under 35 U.S.C. § 103(a) in view of *Carr* and *Unger*.

Claim Group II

A. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 102(B) BECAUSE *CARR* DOES NOT DISCLOSE GENERATING A FIRST CODE WORD TABLE CONTAINING CODE WORDS FOR A PLURALITY OF CHARACTER STRINGS FOUND IN A FIRST ELECTRONIC MAIL (EMAIL) MESSAGE FIELD AND GENERATING A SECOND CODE WORD TABLE CONTAINING CODE WORDS FOR A PLURALITY OF CHARACTER STRINGS FOUND IN A SECOND EMAIL MESSAGE FIELD

Claim Group II is not anticipated under 35 U.S.C. §102(b) for the same reasons as given above with respect to Claim Group I and further due to the additional limitation generating a first code word table containing code words for a plurality of character strings found in a first email message field and generating a second code word table containing code words for a plurality of character strings found in a second email message field.

Appellant's arguments made above with respect to the claims of Claim Group I apply equally to Claim Group II and are incorporated herein by reference. With respect to generating word tables, Appellant's claim 9 recites:

> A method comprising:
> generating a first code word table containing code words for a plurality of character strings found in a first electronic mail (email) message field;
> generating a second code word table containing code words for a plurality of character strings found in a second email message field; and
> encoding character strings in said first field using said first code word table and character strings in said second field using said second code word table.

Appellant submits that *Carr* does not disclose generating a first code word table containing code words for a plurality of character strings found in a first email message field and generating a second code word table containing code words for a plurality of

character strings found in a second email message field. As discussed above, *Carr* discloses reformatting each data packet in a data processing system by associating its static fields with a first packet region and its dynamic fields with a second packet region, assembling a static table that includes static information from an initial data packet's first packet region, identifying static field information in a subsequent data packet's first packet region that is common to the information in the static table, and encoding the common information.

Nevertheless, there is no disclosure in *Carr* of generating a first code word table containing code words for a plurality of character strings found in a first email message field and generating a second code word table containing code words for a plurality of character strings found in a second email message field. Accordingly, Claim Group II is patentable over *Carr*.

For the foregoing reasons, Appellant submits that the Examiner has failed to search and find a printed publication or patent that discloses the claimed invention as set forth in MPEP § 706.02(a).

Claims 10-12 and 14-16 depend from claim 9. Given that dependent claims necessarily include the limitations of the claims from which they depend, Appellant submits that the invention as claimed in claims 10-12 and 14-16 are similarly not anticipated by *Carr*.

Thus, the Examiner erred in rejecting claims 9-12 and 14-16 under U.S.C. § 102(b).

B. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 103(A) BECAUSE NEITHER *CARR* NOR *UNGER* DISCLOSE OR SUGGEST GENERATING A FIRST CODE WORD TABLE CONTAINING CODE WORDS FOR A PLURALITY OF CHARACTER STRINGS FOUND IN A FIRST ELECTRONIC MAIL (EMAIL) MESSAGE FIELD AND GENERATING A SECOND CODE WORD TABLE CONTAINING CODE WORDS FOR A PLURALITY OF CHARACTER STRINGS FOUND IN A SECOND EMAIL MESSAGE FIELD

The Claims of Claim Group II are not obvious in view of *Carr* in view of *Unger* under 35 U.S.C. § 103(a). *Unger* does not disclose or suggest generating a first code word table containing code words for a plurality of character strings found in a first email message field and generating a second code word table containing code words for a plurality of character strings found in a second email message field.

As discussed above, *Carr* does not disclose or suggest such a limitation. As a result, any combination of *Carr* and *Unger* would also not disclose or suggest generating a first code word table containing code words for a plurality of character strings found in a first email message field and generating a second code word table containing code words for a plurality of character strings found in a second email message field.

For the foregoing reasons, Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness as set forth in MPEP § 706.02(j). Specifically, the Examiner has failed to show that "[t]he teaching or suggestion to make the claimed combination ... [is] found in the prior art, and not based on Appellant's disclosure," as required by In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Thus, the Examiner erred in rejecting claims 10, 11 and 16 under 35 U.S.C. § 103(a) in view of *Carr* and *Unger*.

IX. CONCLUSION

Careful review of the Examiner's rejections shows that the Examiner has failed to provide any reference, or combination of references of the prior art that shows all of the elements of each appealed claim. Therefore, Appellant respectfully submits that all appealed claims in this application are patentable and were improperly rejected by the Examiner during prosecution before the United States Patent and Trademark Office. Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with a check for $330.00 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. § 1.17(c). Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 8, 2004

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X. APPENDIX OF CLAIMS (37 C.F.R. § 1.192(c)(9))

The claims on appeal read as follows:

1. A method comprising:

identifying a first field and a second field within an electronic mail (email) message;

applying a first set of code words to encode data in said first field; and

applying a second set of code words to encode data in said second field.

2. The method as in claim 1 further comprising:

generating said first set of code words based on the frequency with which character strings represented by said code words are found within said first field; and

generating said second set of code words based on the frequency with which character strings represented by said code words are found within said second field.

3. The method as in claim 2 wherein character strings which are relatively more common within said first field are represented by relatively shorter code words in said first set of code words and character strings which are relatively more common within said second field are represented by relatively shorter code words in said second set of code words.

4. (Original) The method as in claim 1 wherein said first field is an email header field and said second field is an email text field.

5. The method as in claim 1 wherein said first field is an address book field and said second field is an email message field.

6. The method as in claim 1 further comprising:

encoding ASCII text in said message in a 6-bit character format.

7. The method as in claim 6 further comprising:

providing one or more 6-bit escape sequences indicating that code following said sequence represents data compressed using a particular compression technique.

8. The method as in claim 6 wherein relatively common characters are encoded using 6 bits and relatively uncommon characters are encoded using two successive sequences of 6 bits.

9. A method comprising:

generating a first code word table containing code words for a plurality of character strings found in a first electronic mail (email) message field;

generating a second code word table containing code words for a plurality of character strings found in a second email message field; and

encoding character strings in said first field using said first code word table and character strings in said second field using said second code word table.

10. The method as in claim 9 further comprising:

initially performing a statistical analysis of character strings found in said first email message field and said second email message field to determine a frequency of occurrence of each of said character strings.

11. The method as in claim 10 wherein character strings occurring relatively more frequently in said first field and said second field are associated with relatively

shorter code words in said first code word table and said second code word table, respectively.

12. The method as in claim 9 wherein said first field is an email address field.

14. The method as in claim 9 further comprising:

encoding said message further using one or more alternate compression techniques.

15. The method as in claim 14 wherein one of said alternate compression techniques comprises converting ASCII characters into a 6-bit character format.

16. The method as in claim 14 wherein one of said techniques comprises identifying strings in said first or second fields based on a location of said strings in a spell-check dictionary.

22. A machine readable medium having program code stored thereon which, when executed by a machine, causes said machine to perform the operations of:

identifying a first field and a second field within an electronic mail (email) message;

applying a first set of code words to encode data in said first field; and

applying a second set of code words to encore data in said second field.

23. The method as in claim 22 comprising additional program code to cause said processor to perform the operations of:

generating said first set of code words based on the frequency with which character strings represented by said code words are found within said first field; and

generating said second set of code words based on the frequency with which character strings represented by said code words are found within said second field.

24. The machine-readable medium as in claim 23 wherein character strings which are relatively more common within said first field are represented by relatively shorter code words in said first set of code words and character strings which are relatively more common within said second field are represented by relatively shorter code words in said second set of code words.

25. The machine-readable medium as in claim 22 wherein said first field is an email header field and said second field is an email text field.

26. The machine-readable medium as in claim 22 wherein said first field is an address book field and said second field is an email message field.

27. The machine-readable medium as in claim 22 comprising additional program code to cause said processor to perform the operations of:

encoding ASCII text in said message in a 6-bit character format.

28. The machine-readable medium as in claim 27 comprising additional program code to cause said processor to perform the operations of:

providing one or more 6-bit escape sequences indicating that code following said sequence represents data compressed using a particular compression technique.

29. The machine-readable medium as in claim 27 wherein relatively common characters are encoded using 6 bits and relatively uncommon characters are encoded using two successive sequences of 6 bits.